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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/647,378 | 11/08/2000 | Itaru Kawakami | KOIK-T0185 | 7333 |

7590 09/22/2005

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EXAMINER

CALLAHAN, PAUL E

ART UNIT PAPER NUMBER

2137

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|-----------------------------------------------------------------------|--------------------------------------|----------------------------------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 09/647,378 | Applicant(s) KAWAKAMI ET AL. | |
| | Examiner Paul Callahan | Art Unit 2137 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.

RD

Continuation Sheet (PTOL-303)

Continuation of 11. Does NOT place the application in a condition for allowance because:

Applicant's arguments filed 7-25-2005 have been fully considered but they are not persuasive.

The Applicant argues that the Examiner has improperly relied on the claims of a prior art reference in rebuttal to his arguments, previously presented. In support of this assertion, the applicant cites *In Re Benno*, 226 U.S.P.Q. 683, 686, Fed. Cir. 1985. The Applicant has misconstrued the holding of the Court in *Benno*, and has cited passages from the case out of context, giving them a meaning contrary to that intended by the Court.

In *Benno*, the Board of Patent Appeals and Interferences added its own rejection to those of the Examiner in the case, writing in it's decision to finally reject the claims: "While Danti discloses, in figure 1, a package in which both webs encircle the containers in a vertical direction, **claim 1 of Danti is broad enough to read on** a package with the inner web encircling the containers in a horizontal direction..." The Court did not object to the Board's use of a claim of a Patent in support of a rejection *per se*, but instead objected to the use of the claim of a Patent to *infer* the teaching of features not *explicitly* found within the claim language itself. The Court wrote: "The **scope** of a Patent's claims determines what infringes the Patent; it is no measure of what it discloses." The best interpretation of the Court's holding is that it was referring to the improper use of the assumed **scope** of a claim of a Patent to teach features not explicitly found within the claim or disclosure of the Patent. The Court then, was merely defining a type of *Parole Evidence* rule for the use of the claims of a Patent in a rejection, and not issuing a blanket prohibition on the practice.

In the instant Application, the Examiner did not improperly refer to the *scope* of the claims in the Hsu '023 Patent. Instead, only the features found within the language of the claim itself were used in the Response to Arguments section of the previous

Continuation Sheet (PTOL-303)

Office Action. The Examiner wrote; "The Applicant argues that Hsu does not teach receiving data in one format, and compressing the data in a second format. Yet a careful reading of Hsu shows that such is indeed taught at claim 1, where application driven data transforms are performed at first and second logical areas, and claim 4 where these transforms are taught as encryption and or compression." A careful reading of the cited paragraph reveals that the Examiner referred only to features explicitly taught by the claims, and not to any that might be inferred by consideration of the scope of the claim. As per the Court's holding in *In Re Benno*, the Examiner's rebuttal is proper.

The Applicant asserts that the Final Office Action failed to properly address his arguments presented in traverse of the rejections of claims 15, 19, and 21 as anticipated by Iwayama '083. The Applicant's arguments are moot because the feature argued; "...a comparison between a computation of a computing structure and that of a past computation..." is not found in any of the claims. This fact also renders moot the Applicant's arguments presented in traverse of the rejections of claims 15, 17, 18, 19, 21, and 28-35.

The Applicant's argues in traverse of the rejection of the claims 11-13 as anticipated by Hsu '023, by asserting the cited portions of Hsu do not explicitly teach conversion from an MP3 format to ATRAC3 formatting. Even assuming *arguendo* that Hsu fails to teach such, the Applicant's arguments fail since such language is found nowhere in the claims. The cited portions of Hsu do indeed read on a reasonably broad interpretation of the claim language.

Paul Callahan

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SUPERVISORY PATENT EXAMINER